

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1, 3-10, and 12-18 are pending in the application.

In the outstanding Office Action, Claims 1, 3, 10, 12, and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chestnut (U.S. Patent No. 6,041,114) in view of Perkins (U.S. Patent No. 6,614,889); and Claims 4, 5, 7, 9, 13, 14, 16, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chestnut in view of Alfred et al. (U.S. Patent No. 5,984,504, hereinafter Alfred).

Briefly recapitulating, Claim 10 is directed to a communication method used for carrying out call forwarding by a communication system. The method includes (a) receiving a call establishment request from a communication terminal; (b) sending, to said communication terminal, a call forwarding destination information including information on at least a call forwarding destination; (c) receiving information on a call forwarding destination which is selected by a caller from said communication terminal, and allowing said communication terminal and said call forwarding destination to communicate with each other according to said information on said call forwarding destination, and; (d) establishing a communication mode between said communication system and said communication terminal according to said information on said call forwarding destination. *The communications mode comprises one of an email mode, a fax mode, and a chat mode.* Claim 1 is directed to an apparatus corresponding to the method of Claim 10. The claimed method and corresponding

apparatus improves on the prior art because it allows callers to select a call forwarding destination and a call forwarding mode.<sup>1</sup>

Independent Claim 13 is directed to a communication method used for carrying out call forwarding by a communication system. The method includes (a) receiving a call establishment request from a communication terminal; (b) sending, to said communication terminal, a call forwarding destination information including information on at least a call forwarding destination; (c) receiving information on a call forwarding destination which is selected by a caller from said communication terminal; (d) performing media conversion between communication modes of said call forwarding destination and said communication terminal; and (e) allowing said communication terminal and said call forwarding destination to communicate with each other by performing media conversion. *The media conversion includes voice-to-text conversion and text-to-voice conversion.* Claim 4 is directed to an apparatus corresponding to the method of Claim 13. The claimed method and corresponding apparatus improves on the prior art because it allows callers to select a call forwarding destination and a call forwarding mode.<sup>2</sup>

Chestnut teaches a method and device for callers to select a call forwarding destination phone number or mail box from a menu presented by a call forwarding manager.<sup>3</sup> As noted in the Official Action, Chestnut does not teach or suggest a method or a device for callers to select a call forwarding destination and a communications mode comprising ‘one of an email mode, a fax mode, and a chat mode’ as recited in Claims 1 and 10. Also as noted in the Official Action, Chestnut does not teach or suggest call forwarding with ‘voice-to-text conversion and text-to-voice conversion’ as recited in amended Claims 4 and 13.

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<sup>1</sup> Specification, page 1, lines 28-34.

<sup>2</sup> Specification, page 1, lines 28-34.

<sup>3</sup> Chestnut, column 5, lines 26-62.

Perkins discloses a switching device configured to switch one phone line between multiple devices, including a computer and a fax machine.<sup>4</sup> However, contrary to the Official Action, like Chestnut, Perkins does not disclose or suggest “establishing a communication mode between said communication system and said communication terminal according to said information on said call forwarding destination, wherein the communications mode comprises one of an email mode, a fax mode, and a chat mode.” Perkins is limited to mere switching and, like Chestnut, does not establish a text-based mode of communications (i.e., Applicants’ claimed one of an email mode, a fax mode, and a chat mode) based on a call forwarding destination). Furthermore, Chestnut explicitly and exclusively recites that voice calls are routed to voice-capable devices and facsimile calls are routed to facsimile-capable devices.<sup>5</sup> Similarly, Perkins discloses that voice calls are switched to voice-capable devices, facsimile calls are switched to facsimile-capable devices, and data calls are switched to data-capable devices.<sup>6</sup> Thus, Applicants submit that both Chestnut and Perkins each teach away from Applicants’ claimed invention.

Regarding modes, Perkins discloses several.<sup>7</sup> For example, Mode 1 is “modem connected to communication line, fax disconnected”. The mode of connection in Perkins apparently means a pattern of connection between devices. In contrast, the claimed communication mode is to be established between the communication system and the communication terminal, and is not a connection pattern between devices. Thus, there is no relation between the switching device of Perkins and the claimed feature of “establish[ing] a communication mode between said communication system and said communication terminal according to said information one said call forwarding destination”. Thus, Applicants submit

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<sup>4</sup> Perkins, abstract, Figure 1.

<sup>5</sup> Chestnut, column 10, lines 43-54.

<sup>6</sup> Perkins, Figure 3.

<sup>7</sup> Perkins, column 5, lines 1-43.

that even if the different modes of Perkins were to be incorporated into Chestnut, the combination would equate to Applicants' claimed communication mode between the terminal and the destination since the claimed communication mode is not a connection pattern between devices.

As to Claims 4 and 13, Alfred discloses speech-to-text conversion.<sup>8</sup> However, as noted above, Chestnut explicitly and exclusively recites that voice calls are routed to voice-capable devices and facsimile calls are routed to facsimile-capable devices.<sup>9</sup> That is, there is no reference or suggestion in Chestnut to route facsimile calls to voice-capable devices or voice calls to facsimile devices. More importantly, Chestnut is limited to voice and facsimile communications. That is, there is no reference in Chestnut of any type of text-based communications.

Thus, Applicants submits there is no motivation to combine the teachings of Alfred and Chestnut. Therefore, Applicants submit the rejections based on the combination of Alfred and Chestnut constitutes an impermissible hindsight reconstruction of Applicants' claimed inventions.

Furthermore, the Official Action suggests that Chestnut discloses a media conversion part since the disclosed telecommute server instructs a PBX to forward a call to a telephone extension or a voice messaging system. The Official Action further seems to suggest that the telecommute server Chestnut is equivalent to Applicants' claimed media conversion part. However, Applicants' claimed media conversion part is a part via which the communication terminal and the call forwarding destination communicate with each other while performing media conversion. In contrast, in Chestnut when a call is forwarded to the voice messaging system, a calling party and a call forwarding destination do not communicate with each other.

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<sup>8</sup> Alfred, Figure 4.

<sup>9</sup> Chestnut, column 10, lines 43-54.

Thus, Applicants submit that Chestnut does not suggest Applicants' claimed media conversion part. Since Chestnut does not suggest the claimed media conversion part, the speech recognition system of Alfred cannot be incorporated into Chestnut.

Thus, for another reason, Applicants submits there is no motivation to combine the teachings of Alfred and Chestnut. Therefore, Applicants submit the rejections based on the combination of Alfred and Chestnut constitutes an impermissible hindsight reconstruction of Applicants' claimed inventions.

In view of the foregoing comments, Applicants submit the inventions defined by Claims 1, 4, 10, and 13, and all claims depending therefrom, are neither anticipated nor rendered obvious by the asserted prior art for at least the reasons stated above.<sup>10</sup>

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



Bradley D. Lytle  
Attorney of Record  
Registration No. 40,073  
Michael E. Monaco  
Registration No. 52,041

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
BDL/MEM/kkn  
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<sup>10</sup> MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."